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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,744	12/21/2001	Richard Soltero	9233-71	3700

20792 7590 09/26/2003

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EXAMINER

TELLER, ROY R

ART UNIT PAPER NUMBER

1654

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/036,744	SOLTERO ET AL.	
	Examiner	Art Unit	
	Roy Teller	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-467 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-467 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following is required under 35 U.S.C. 121:

- I. Claims 1-53, 248-281, 371-398, and 446-458, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate, are for example classified in class 530, subclass 303.
- II. Claims 54-108, 282-319, and 399-414, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate using formula I, are for example classified in class 530, subclass 303.
- III. Claims 109-153, and 415-424, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate using formula II, are for example classified in class 530, subclass 303.
- IV. Claims 154-197 and 425-434, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate using formula III, are for example classified in class 530, subclass 303.
- V. Claims 198-226, 320-365, and 435-445, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate using formula IV, are for example classified in class 530, subclass 303.

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- VI. Claims 227-247, and 366-370, drawn to a method of synthesizing an insulin polypeptide-oligomer conjugate using formula V, are for example classified in class 530, subclass 303.
- VII. Claims 459-467, drawn to a method of synthesizing a C-peptide polypeptide-oligomer conjugate, are for example classified in class 530, subclass 303.

The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I-VII have different chemical structures due to the differences in oligomers used in the polypeptide-oligomer conjugates. Each unique chemical structure is patentably distinct.

Because the inventions are distinct for the reasons given above and since they have acquired a separate status in the art as shown by their divergent subject matter, and/or are separately and independently searched, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is (703)305-4243. The examiner can normally be reached on Monday-Friday from 5:30 am to 2:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

RT
1654
9/24/03

RT



CHRISTOPHER R. TATE
PRIMARY EXAMINER